

REMARKS

Status of the claims:

With the above amendments, claims 1-20 are amended and claims 22-27 are added. Thus, claims 1-27 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 1 comes from original claims 11 and 12, as well as part of original claim 14. All other amendments are non-narrowing in scope and are simply meant to place them in a better form for U.S. claims practice. New claims 22-27 have support in the claims from which they depend. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §102

Claims 1-10 and 19-21 are rejected under 35 USC §102(b) as being anticipated by DE '461 (DE 19753461).

Applicants traverse.

Applicants have amended claim 1 to recite particular types of the OH-functional compound containing at least one and up to 10 OH groups. DE '461 does not disclose these compounds. In particular, DE '461 does not disclose the combination of a complex between a boric acid compound and an OH-functional compound as currently claimed in claim 1. Moreover, Applicants note that the Examiner did not reject claims 11, 12, and 14 in

this rejection, whose subject matter has partially been incorporated into claim 1. Accordingly, the rejection is inapposite because DE '461 does not disclose all of the elements of the instantly claimed invention. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §103

Claims 11-18 are rejected under 35 USC §103(a) as being unpatentable over DE '461 (DE 19753461).

Present Invention

The present invention, as recited in claim 1, relates to an elastomer material based on N-alkylaziridino compounds with a base component which contains an aziridino compound and with a catalyst component which contains at least one acid-acting compound, both components being mixed before use, wherein, as the acid-acting compound of the catalyst component, one or more boric acid complexes are used which can be obtained by reaction of boric acid and/or a boric acid derivative with at least one OH-functional compound, the OH functions being able to be present wholly or partly protected, and this reaction being carried out either as an upstream reaction between boric acid and/or a boric acid derivative and at least one such OH-functional compound or during or after the preparation of the

catalyst component or by mixing the catalyst component with the base component which then contains at least one such OH-functional compound and the at least one OH-functional compound containing at least one and up to 10 OH groups wherein the OH-functional compound is selected from the group consisting of

i) compounds which contain at least one 1,2-dihydroxy and/or at least 1,3-dihydroxy group;

ii) compounds which have at least one phenolic OH group; and

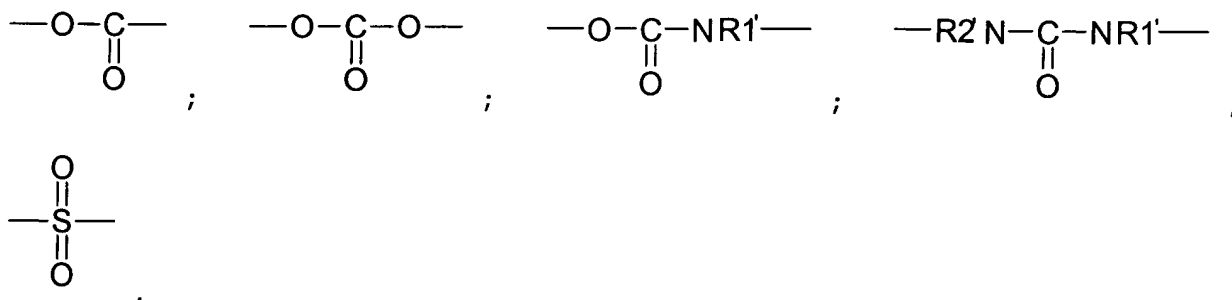
iii) α -hydroxy-carboxylic acids,

wherein the OH-functional compound containing at least one and

up to 10 OH groups has the general structural formula
$$\text{R1}-\overset{\text{O}}{\underset{\parallel}{\text{C}}}-\text{OH}$$

and/or
$$\begin{array}{c} \text{R1} \\ | \\ \text{R3}-\text{C}-\text{OH} \\ | \\ \text{R2} \end{array}$$
, wherein R1, R2 and R3 represent the same or different radicals selected from the group consisting of hydrogen, aliphatic, cycloaliphatic, aromatic and araliphatic substituents with 1 to 30 C atoms in each, of which one or more

C atoms can be replaced by $-\text{O}-$; $-\text{S}-$; $\diagup \text{C}=\text{O}$;



R1' and R2' being the same or different wherein R1' and R2' are aliphatic, cycloaliphatic, aromatic or araliphatic bivalent radicals with 1 to 30 C atoms.

Disclosure of DE '461

DE '461 discloses preparations said to have improved curing behavior, which are characterized in that they contain 0.0005 to 50 wt. % of soluble and/or fine-particle organic and/or inorganic alkaline earth and/or alkali metal compounds. The preparations are said to be useful for bonding, sealing, casting and coating substrates, also in medical dental and technical dental preparations, and for making impressions of articles such as dental impressions.

Removal of the Rejection over DE '461

DE '461 fails to disclose or suggest the instant invention. In particular, DE '461 does not disclose or suggest an OH-functional compound that is selected from the group consisting of i) compounds which contain at least one 1,2-dihydroxy and/or

at least 1,3-dihydroxy group; ii) compounds which have at least one phenolic OH group; and iii) α -hydroxy-carboxylic acids as is claimed in instant claim 1 and upon which claims 11-18 are either directly or indirectly dependent. Accordingly, Applicants assert that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over DE '461. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). In particular, the Examiner has failed to meet the third element to make a *prima facie* obviousness rejection. Because DE '461 does not disclose the OH-functional compound that is claimed in claim 1, DE 461 cannot render obvious the instant invention.

The Examiner points to column 4, line 39 (in US Patent No. 6,599,960, which corresponds to DE '461) as disclosing polyhydric compounds. Applicants submit that this generic disclosure encompasses an infinite number of compounds and is

insufficient to render the instantly claimed invention obvious. The Examiner's attention is directed to *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994) wherein it was found that a genus containing a large, but finite number of possible compounds was unable to render obvious a small genus. Accordingly, Applicants submit that a genus that has an infinite number of compounds cannot render obvious a small genus as disclosed in claim 1. In other words, it is not obvious to select specific polyhydric alcohols that are not disclosed in DE '461 to arrive at the instant invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §§101 and 112, second paragraph

Claim 20 is rejected under 35 USC §§101 and 112, second paragraph for a "use" claim. Applicants have amended claim 20 so that it is no longer a "use" claim. Applicants believe that with this amendment that the rejections have been obviated. Withdrawal of the rejections is warranted and respectfully requested.

With the above remarks and amendments, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.


If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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